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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT	:	Youn-Man Lee	DOCKET NO.:	5000-1-110
SERIAL NO.	:	09/621,384	EXAMINER	: Naghmeh Mehrpour
FILED	:	July 21, 2000	ART UNIT	: 2617
FOR	:	METHOD FOR SAVING BATTERY BY CONROLLING DISPLAY IN PORTABLE TELEPHONE		

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In Response to the "Notice of Non-Compliant Appeal Brief" dated November 21, 2006, Applicant encloses amendment originally submitted on September 1, 2006 with corrections deemed to be non-compliant.

No additional fees are believed to be necessitated by the foregoing amendment. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 502-470 for any underpayment, or credit any overages.

Respectfully submitted,

Date: January 3, 2007

By: Steve Cha
Attorney for Applicant
Registration No. 44,069

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventor	:	**Youn-Man Lee**
Application No.	:	**09/621,384**
Filed	:	**July 21, 2000**
For	:	**METHOD FOR SAVING BATTERY BY CONTROLLING DISPLAY IN PORTABLE TELEPHONE**

APPEAL BRIEF

On Appeal from Group Art Unit 2686

Date: January 3, 2007

Steve Cha
Attorney for Applicant
Registration No. 44,069

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Steve S. Cha, Reg. No. 44,069
(Name of Registered Representative)

(Signature and Date)

TABLE OF CONTENTS

		Page
I.	REAL PARTY IN INTEREST.....	3
II.	RELATED APPEALS AND INTERFERENCES.....	3
III.	STATUS OF CLAIMS.....	3
IV.	STATUS OF AMENDMENTS.....	3
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	3
VI.	GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	4
VII.	ARGUMENT.....	4
VIII.	CLAIMS APPENDIX.....	12
IX.	EVIDENCE APPENDIX.....	16
X.	RELATED PROCEEDINGS APPENDIX.....	16

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, Samsung Electronics, Co., Ltd., and not the party named in the above caption.

II. RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or interferences known to Appellant which will directly effect or be directly affected by or have a bearing on the Board's decision in this appeal, Appellant is not aware of any such appeals or interferences.

III. STATUS OF CLAIMS

Claim 1-18 have been cancelled. Remaining claims 19-36 are pending, stand finally rejected and form the subject matter of the present appeal.

IV. STATUS OF AMENDMENTS

The instant application was filed on July 21, 2000 and the subject matter contained therein was subsequently rejected in an Office Action dated July 17, 2002. Prosecution of the instant application continued through additional Office Actions, which rejected the subject matter recited in the claims, and applicant's responses to the rejections.

On August 4, 2005, an Office Action was issued which rejected claims 1-18 under 35 USC 103(a) as being unpatenable over Son (USP no. 6,278,887) in view of Okada

(USP no. 6,317,614). A Response to the Office Action of August 4, 2005, was filed on November 1, 2005, wherein claims 1-18 were cancelled and claims 19-36 were added.

On March 14, 2006, a Final Office Action was issued which rejected claims 19-36 under 35 USC 103(a) as being unpatentable over Son (USP no. 6,278,887).

On June 27, 2006 a telephonic interview was held between the Examiner and Applicant's representative to discuss claim 19 and the Son reference. A written record of interview held on June 27, 2006 was filed June 28, 2006 pursuant to 37 CFR 1.133.

On July 12, 2006, a Notice of Appeal was filed, with appropriate fee and a petition for a one-month extension of time to file same. No amendment to the claims has been filed after final rejection of the claims.

On September 1, 2006, an Appeal Brief, with appropriate fee, was timely filed within two months of filing the Notice of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter claimed as the instant invention is described in independent claims 19 (a battery saving method), 27 (a computer program product providing instruction to a processor for executing the method steps recited in claim 19) and 28 (a portable telephone having a battery saving capability). The remaining claims, which depend from one of the independent claims, recite additional aspects of the invention calimed.

With regard to claim 1, which is representative of the invention, this claim recites a battery saving method for controlling a display of a portable telephone includes providing the display with a liquid crystal display (LCD) 131 and, after power-on of the

telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment (FIG. 2, ref. no. 213; page 7, lines 17-19; page 9, lines 8-10).

The telephone preferably includes a send key, an answering key and a plurality of other input keys (page 6, lines 14-15; FIG. 2, ref. no. 205; FIG. 3, ref. no. 309). The maintaining of the back light off preferably persists unless and until one of two events occurs, the two events being pressing the send key and receiving a ring signal for call termination (page 7, lines 15-19; page 9, lines 4-10).

With regard to claim 27, this claim recites a computer program product that provides instruction to a processor to enables the processor to perform the method steps recited in claim 19. (see page 6, line 7).

With regard to claim 28, this claim recites a portable telephone comprising a display and a processor configured to maintain the display on until a call is call is established and a predetermined time period has expired since establishment of the call. (see Figure 1).

VI. GROUND FOR REJECTION TO BE REVIEWED ON APPEAL

The matter at issue is whether claims 19-36 are unpatentable under 35 U.S.C. 103(a) over U.S. Patent No. 6,278,887 to Son et al. ("Son").

VII. ARGUMENT

Rejection of Claims 19-36 under 35 U.S.C. 103(a)

By applying a one-reference obviousness rejection, the Office Action tacitly acknowledges that, due to a difference between the Son disclosure and the language of claim 19, Son fails to anticipate the present claim 19.

The Office fails to specify this difference. The treatment of this claim rejection by the Office Action is therefore not in keeping with current, prevailing standards of patent examination procedure.

> Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:
>
> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. (MPEP 2141(I)).

The Office Action has provided no guidance whatsoever as to those "differences" or motivation for purportedly overcoming those differences.

In addition, although the "Response to Arguments" section cites "new" grounds of rejection, the single reference applied was already applied in the prior ground of rejection. This reference, moreover, is specifically addressed in the applicant's amendment to which the Office Action "responds." Accordingly, the "Response to Arguments" section appears no less than non-responsive.

A subsequent telephonic interview with the Examiner (June 27, 2006) substantially involved the following discussion.

Claim 19 recites, ". . . after power-on of the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment."

Son is directed to a terminal having "the ability to automatically turn the display on upon receipt of an incoming call, or upon the opening of a flip panel" (col. 5, lines 52-55). Son appears to be designed on the following assumptions. The opening of a flip panel by the user would tend to indicate that the user is imminently planning to look at the display (col. 5, lines 52-55), and consequently a need to immediately turn on the LCD. The opening of the flip panel also tends to indicate that the user is paying attention to the phone. If key strokes are no longer entered after a particular period of time, the LCD can be turned off. Once the LCD is off, Son keeps it off until the flip panel is opened, a call is received, or a key is actuated (col. 5, lines 52-55; FIG. 2).

Even today, however, and especially at the time the invention was made, many portable telephones do not have a flip panel. A phone without a flip panel is without any easy way to know when the user is paying attention to the display, e.g., to see the current time or to check whether a particular icon is displayed.

Son discloses turning on the display at power-on, and then turning the display off after a predetermined time period that any keystroke resets (FIG. 2). When a call is initiated, the display is turned back on (col. 5, line 66 - col. 6, line 6; FIG. 3).

Son turns off the LCD (FIG. 2, step 138) shortly after the LCD was turned on at power-on (col. 4, lines 52-53: "powering up"). The Son LCD remains off until a key stroke is entered (FIG. 4, step 210) or "a call is initiated" (col. 6, lines 1-3).

In summary, Son is based on a flip phone, and therefore has means for detecting when the user is looking at the phone (col. 5, lines 52-55). Son, after turning the LCD on at power-on, turns off the LCD at the expiry of a timeout period renewable by keyboard activity. Once the LCD is off, Son keeps it off until the flip panel is opened, a call is received, or a key is actuated (col. 5, lines 52-55; FIG. 2).

The present claim 19, by contrast, recites, ". . . after power-on of the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment."

The position of the Examiner is not clear from the record, but seems to be as follows.

Son discloses after turning the LCD on at power-on, turning off the LCD at the expiry of a timeout period renewable by keyboard activity. However, Son also seems to suggest that any combination of the display, the display backlight and the keyboard backlight can be implemented for saving power (col. 4, lines 35-40). Thus, although the present claim 19 relates only to the display, this last citation could be construed as suggesting flexibility in general with regard to the display implementation.

The Office Action then seemingly proposes that, if Son is designed to retain its shutting off of the LCD after the predetermined timeout period (col. 6, lines 12-19), while eliminating the Son feature of turning off the LCD shortly after power-on, Son can be made to resemble the present claim 19.

The appellant does not think that such a modification of Son would have been obvious.

To meet the language of claim 19, Son must be assumed to already have a timeout mechanism implemented for shutting off the LCD during a call to save power (col. 6, lines 11-12: "to provide additional power savings"). That mechanism can also be used to realize the Son power-saving feature of shutting off the LCD after expiry of a timeout period following power-on (col. 4, lines 52-55; FIG. 2). Son experiences no problem in incorporating both functions, because Son can rely on its flip panel to activate the LCD at the time the user desires.

Based at least on the foregoing, it is unclear by what reasoning one would have been motivated to selectively eliminate the Son timeout-based shutting off of the LCD after power-on, while retaining the Son feature of shutting off the LCD upon timeout during a call.

The appellant further notes that the flexibility expressed by Son as to what separate sub-system, i.e., display, display backlight, or keypad backlight, is to be outfitted for power saving, does not fairly suggest selectively eliminating power-saving features of a single sub-system. This is especially so, where the power-saving mechanism that could implement both features in the single sub-system is already present. In particular, there does not appear to be any suggestion of, or motivation for, selectively foregoing taking advantage of a power-saving mechanism already in place.

During the telephonic interview with the Examiner (June 27, 2006), the Examiner suggested that claim 19 is met if someone calls a Son phone before expiry of the predetermined period following power-on.

The applicant suggested that the above hypothetical situation does not amount to, or render obvious, "A battery saving method for controlling a display of a

portable telephone, comprising:. . . after power-on of the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment."

For at least all of the above reasons, Son fails to anticipate or render obvious the present invention as recited in claim 19.

Computer program claim 27 and Apparatus claim 28 are based on method claim 19, and is deemed patentable over the cited reference for at least the same reasons set forth above with regard to claim 19.

Claim 21 depends from claim 19 which has been shown to be patentable over Son and is likewise deemed to be patentable for at least the same reasons.

However, claim 21 individually recites an additional aspect that is deemed to distinguish patentably over Son.

In particular, claim 21 recites, ". . . providing a backlight for the LCD . . . wherein said telephone includes a send key, an answering key and a plurality of other input keys, and wherein maintaining of the back light off persists unless and until one of two events occurs, the two events being pressing the send key and receiving a ring signal for call termination."

Son turns the back light on upon entry of a key stroke (FIG. 4, step 210) and upon receipt of a call (FIG. 5, step 248), albeit subject to low-light conditions being likely (col. 7, line 5; FIG. 4, step 208; FIG. 5, step 246).

In any event, Son fails to disclose or suggest the above-quoted aspect of claim 21.

The Office Action cites to lines 34-40 of column 8, which pertain to differentiating between keys in setting time intervals related to the pressing of the respective key.

The passage also mentions that the send key is oftentimes the last button entered in placing or accepting a call.

At least since Son will, if the back light is to be used at all (col. 7, line 5; FIG. 4, step 208; FIG. 5, step 246), turn on the back light upon keying in the destination phone number preparatory to placing a call (FIG. 4, step 210), i.e., before pressing the Son send key to place the call, Son does not disclose or suggest waiting until the Son send key is pressed. Son accordingly fails to disclose or suggest, ". . . providing a backlight for the LCD . . . wherein said telephone includes a send key, an answering key and a plurality of other input keys, and wherein maintaining of the back light off persists unless and until one of two events occurs, the two events being pressing the send key and receiving a ring signal for call termination."

Nor does there seem to be motivation to modify Son to resemble the present claim 21.

The Office Action is silent as to motivation, as to claim 21 and all other claims.

The only citation by the Office Action regarding claim 21 is to lines 34-40 of column 8, which pertain to differentiating between keys in setting time intervals related to the pressing of the respective key. As to the Son send key oftentimes being the last button entered in placing or accepting a call, Son suggests that the send key may therefore trigger a shorter timer whose expiry shuts off the LCD or back light. It is

unclear how this aspect of Son could properly be deemed to provide motivation to modify Son so as to resemble the present claim 21.

Claim 30 is an apparatus claim based on method claim 21 and is deemed to be patentable over Son merely by virtue of depending from base claim 28 which has been shown to be patentable over Son.

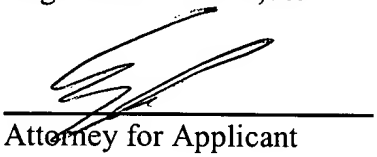
In addition, for at least the same reasons set forth above with regard to claim 21, claim 30 likewise is deemed, based its individual, further merits, to distinguish patentably over Son.

Each of the other rejected claims depends from base claim 19 or 28 and is deemed to distinguish patentably over the applied reference for at least the same reasons set forth above for its base claim.

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fail to anticipate or render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,

Steve S. Cha
Registration No. 44,069



Attorney for Applicant

Date: January 3, 2007

SC/cg

VIII. CLAIMS APPENDIX

1-18 (Cancelled)

19. (previously presented) A battery saving method for controlling a display of a portable telephone, comprising:

providing said display with a liquid crystal display (LCD); and,

after power-on of the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.

20. (previously presented) The method of claim 19, further comprising;

providing a backlight for the LCD; and,

if there has been no call since power-on, maintaining the back light off as long as no call is placed or received.

21. (previously presented) The method of claim 20, wherein said telephone includes a send key, an answering key and a plurality of other input keys, and wherein the maintaining of the back light off persists unless and until one of two events occurs, the two events being pressing the send key and receiving a ring signal for call termination.

22. (previously presented) The method of claim 21, further comprising turning off the backlight upon the expiration of said period.

23. (previously presented) The method of claim 22, further comprising turning on the LCD when the established call has ended.

24. (previously presented) The method of claim 23, further comprising maintaining, if there has been a call since power-on, the back light off as long as no call is placed, or received, subsequent to the most recent call.

25. (previously presented) The method of claim 19, further comprising:

providing said display with a back light for the LCD; and,

if there has been a call since power-on, maintaining the back light off as long as no call is placed, or received, subsequent to the most recent call.

26. (previously presented) The method of claim 19, wherein said telephone includes a send key and an answering key, respectively, for placing and answering phone calls, and further includes a plurality of other input keys.

27. (previously presented) A computer program product having a computer readable medium in which is embeddable a program having instructions executable by a processor for performing the method of claim 19.

28. (previously presented) A portable telephone, comprising:

a display that includes a liquid crystal display (LCD); and

a processor configured for, after power-up of the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.

29. (previously presented) The telephone of claim 28, further comprising a back light for the LCD, wherein said processor is configured for, if there has been no call since power-on, maintaining the back light off as long as no call is placed or received

30. (previously presented) The telephone of claim 29, further comprising a send key, an answering key and a plurality of other input keys, wherein the maintaining of the back light off persists unless and until one of two events occurs, the two events being pressing the send key and receiving a ring signal for call termination.

31. (previously presented) The telephone of claim 30, wherein said processor is further configured for maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.

32. (previously presented) The telephone of claim 31, wherein said processor is further configured for turning off the backlight upon the expiration of said period.

33. (previously presented) The telephone of claim 32, wherein said processor is further configured for turning on the LCD when the established call has ended.

34. (previously presented) The telephone of claim 33, wherein said processor is further configured for maintaining, if there has been a call since power-on, the back light off as long as no call is placed, or received, subsequent to the most recent call.

35. (previously presented) The telephone of claim 28, comprising a back light for the LCD, wherein said processor is further configured for maintaining, if there has been a call since power-on, the back light off as long as no call is placed, or received, subsequent to the most recent call.

36. (previously presented) The telephone of claim 28, wherein said processor is further configured for maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.

IX. EVIDENCE APPENDIX

The appellant is unaware of any evidence.

X. RELATED PROCEEDINGS APPENDIX

The appellant is unaware of any related proceeding.